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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* SAMUEL N. ZELLNER, MARK J. ENZMANN,
9 and
10 ROBERT T. MOTON, JR.
11

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13 Appeal 2008-005864
14 Application 09/740,375
15 Technology Center 3600
16

17
18 Decided: February 5, 2010
19

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22 *Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.
23 MOHANTY, *Administrative Patent Judges*.
24

25 FETTING, *Administrative Patent Judge*.
26
27

28 DECISION ON APPEAL

STATEMENT OF THE CASE

Samuel N. Zellner, Mark J. Enzmann, and Robert T. Moton, Jr.
(Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of
claims 21-30, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
(2002).

We AFFIRM.

The Appellants invented a method of providing an identity-blocking
service, obtaining an identity of a user operating a wireless communication
device; obtaining information about a location of the user; and transferring
the information about the location of the user to a third party without
disclosing the identity of the user to the third party or transferring the
identity information for the user to a third party without disclosing the
location information for the user to the third party. (Spec. 5:3-6:7).

An understanding of the invention can be derived from a reading of
exemplary claim 21, which is reproduced below [bracketed matter and some
paragraphing added].

21. A method of sending an advertisement to a user operating a
wireless communication device, comprising:
[1] sending first information about a location of the user
to a content provider
that provides web content to the wireless communication
device;
[2] sending an indication to the content provider
when the location is continuously changing;
[3] searching a first database
containing a plurality of location-specific advertisements;
[4] selecting a first one of the plurality of location-specific
advertisements
that is associated with the location of the user and

1 is desired to be sent to the user at a stable location that is
2 not continuously changing; and
3 [5] sending the first one of the plurality of location-specific
4 advertisements
5 to the wireless communication device
6 over a communication network
7 when the location is stable and not continuously
8 changing.
9

10 This appeal arises from the Examiner's Final Rejection, mailed May
11 19, 2006. The Appellants filed an Appeal Brief in support of the appeal on
12 April 19, 2007. An Examiner's Answer to the Appeal Brief was mailed on
13 June 19, 2007. A Reply Brief was filed on August 20, 2007.
14

15 PRIOR ART

16 The Examiner relies upon the following prior art:

17 Goldhaber	US 5,794,210	Aug. 11, 1998
18 Hendrey	US 2002/0102993 A1	Aug. 1, 2002

19

20 REJECTIONS

21 Claims 21 and 26 stand rejected under 35 U.S.C. § 103(a) as
22 unpatentable over Hendrey.

23 Claims 22-25 and 27-30 stand rejected under 35 U.S.C. § 103(a) as
24 unpatentable over Hendrey and Goldhaber.
25

26 ISSUES

27 The issue of whether the Appellants have sustained their burden of
28 showing that the Examiner erred in rejecting claims 21 and 26 under 35
29 U.S.C. § 103(a) as unpatentable over Hendrey turns primarily on the

1 predictability of sending an advertisement to a prospect in Hendrey after the
2 prospect entered a store.

3 The issue of whether the Appellants have sustained their burden of
4 showing that the Examiner erred in rejecting claims 22-25 and 27-30 under
5 35 U.S.C. § 103(a) as unpatentable over Hendrey and Goldhaber turns
6 primarily on the patentability of claim 21.

7 8 FACTS PERTINENT TO THE ISSUES

9 The following enumerated Findings of Fact (FF) are believed to be
10 supported by a preponderance of the evidence.

11 *Hendrey*

- 12 01. Hendrey is directed to mobile telecommunications systems that
13 have the ability to deliver advertisements to mobile units and
14 determine a geographically precise location of mobile units in the
15 mobile telecommunications system (Hendrey ¶ 0002).
- 16 02. Once a prospect has been identified, Hendrey creates a tailored
17 advertising message responsive to the prospect's location using a
18 location-sensitive advertising content generation subsystem, and
19 sends it the prospect. At this point the prospect is considered
20 "active" in that the advertisement has been delivered and that the
21 prospect can respond to that advertisement (Hendrey ¶ 0038).
- 22 03. While a prospect is considered active, Hendrey continually
23 monitors the location of the prospect and checks whether a
24 prospect has entered a store relevant to the advertising content. If
25 a prospect has in fact entered the store relevant to the advertising
26 content, the advertisement is considered a success and the

prospect status is changed to be considered inactive. In one embodiment the well-known concept of hysteresis in either time or location would be used to prevent the generation of another advertising message to a customer who has just responded to an advertisement and has not yet left the area used to trigger advertising. If the prospect has not entered the store, Hendrey continues to monitor the prospect's location to determine whether the prospect is likely to respond to the advertisement. If a prospect has moved far from the desired store location, the advertisement is considered to have failed. If too much time has elapsed from the generation of the advertising content the prospect might be considered inactive. If it is determined that the prospect is unlikely to respond to the advertising content sent, the prospect is marked as inactive (Hendrey ¶ 0039-42).

04. Hendrey describes monitoring the general location of a customer over a period of time to see if traveling of the prospect ceased in the general vicinity of the store to determine whether the prospect visited the store or merely stopped nearby it. This provides suggestive evidence that the advertisement caused the user to stop and shop at the store. Hendrey also describes monitoring the travel direction to see if a customer reacts to an advertisement. For example, an advertisement may be triggered when a prospect is within a predetermined radius of the business, such as 500 meters, then determining whether the prospect has moved toward the sponsoring business' store, for example entering within a 100 meter radius of the store. To refine this scenario

1 further, cessation of movement could be detected within such a
2 minimum radius for a duration of time consistent with either
3 making the desired transaction or investigating the advertised
4 product (Hendrey ¶ 0047-48).

5 *Goldhaber*

6 05. Goldhaber is directed to delivering information electronically
7 using techniques for delivering positively and negatively priced
8 intellectual property (including advertising) and attention
9 brokering, orthogonal sponsorship, and/or privacy protection in an
10 electronic information delivery network (Goldhaber 1:4-11).

11 *Facts Related To The Level Of Skill In The Art*

12 06. Neither the Examiner nor the Appellants has addressed the level
13 of ordinary skill in the pertinent arts of systems analysis and
14 programming, advertising, and promotion design. We will
15 therefore consider the cited prior art as representative of the level
16 of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d
17 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings
18 on the level of skill in the art does not give rise to reversible error
19 ‘where the prior art itself reflects an appropriate level and a need
20 for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*
21 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

22 *Facts Related To Secondary Considerations*

23 07. There is no evidence on record of secondary considerations of
24 non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been

1 obvious at the time the invention was made to a person having ordinary skill
2 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550
3 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

4 In *Graham*, the Court held that the obviousness analysis is bottomed
5 on several basic factual inquiries: “[1] the scope and content of the prior art
6 are to be determined; [(2)] differences between the prior art and the claims at
7 issue are to be ascertained; and [(3)] the level of ordinary skill in the
8 pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.
9 “The combination of familiar elements according to known methods is likely
10 to be obvious when it does no more than yield predictable results.” *Id.* at
11 416.

12 “When a work is available in one field of endeavor, design incentives
13 and other market forces can prompt variations of it, either in the same field
14 or a different one. If a person of ordinary skill can implement a predictable
15 variation, § 103 likely bars its patentability.” *Id.* at 417.

16 “For the same reason, if a technique has been used to improve one
17 device, and a person of ordinary skill in the art would recognize that it would
18 improve similar devices in the same way, using the technique is obvious
19 unless its actual application is beyond his or her skill.” *Id.*

20 “Under the correct analysis, any need or problem known in the field
21 of endeavor at the time of invention and addressed by the patent can provide
22 a reason for combining the elements in the manner claimed.” *Id.* at 420.

ANALYSIS

Claims 21 and 26 rejected under 35 U.S.C. § 103(a) as unpatentable over Hendrey.

The Appellants argue these claims as a group. Accordingly, we select claim 21 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Hendrey described the limitations of claim 21 except for sending an advertisement when it is determined the prospect has stopped. The Examiner found that one of ordinary skill would have found it desirable to send an advertisement when a prospect is in a store and concluded that it would have been obvious to a person of ordinary skill in the art to have sent such an advertisement with Hendrey's system (Ans. 3-4).

The Appellants contend that Hendrey does not suggest or teach tracking a location of a user, determining whether the location is constantly changing, and sending advertisements which are desired to be sent when the location is determined to be stable and not constantly changing (App. Br. 8:Top ¶) or selecting a first location-specific advertisement associated with the location of the user and sending it to the wireless device when the location is stable and not continuously changing (App. Br. 8:Bottom ¶ - 9), and that the requisite motivation for modifying the Hendrey reference is lacking (App. Br. 9:Last full ¶).

We disagree with the Appellants. Hendrey describes tracking a location of a user and determining whether the location is constantly changing (FF 04). Hendrey also describes sending advertisements which are desired to be sent when the prospect is active (FF 02) and continually monitoring the location of the prospect and checking whether a prospect has entered a store relevant to the advertising content (FF 03). Thus the only issue is whether it was predictable to one of ordinary skill to send another

advertisement after the location stopped changing because the prospect entered a store. While we agree with the Appellants that Hendrey does not explicitly describe doing so, one of ordinary skill, and indeed most consumers of much lesser skill, had experience with stores providing advertising within their premises prior to the filing date. With such knowledge, one of ordinary skill would have been motivated to provide the electronic equivalent of such in store advertising for promotions beyond that in the advertisement that led the prospect into Hendrey's store. "[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *KSR*, 550 U.S. at 417. "[T]he analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* 550 U.S. at 418. "In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends." *Id.* 550 U.S. at 419. We find that market demand for promotional advertising oriented towards prospects already within a vendor's premises is so notoriously well known as to be such a technique.

Claims 22-25 and 27-30 rejected under 35 U.S.C. § 103(a) as unpatentable over Hendrey and Goldhaber.

The Appellants rely primarily on the arguments in support of claim 21. The Appellants also argue that the features of claims 22-25 and 27-30 have not been taught or suggested by the cited art in the manner claimed (App. Br. 13). "A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."

37 C.F.R. § 41.37(c)(1)(vii) (2007). By the same token, a statement which merely alleges that a claim recites patentable features without even identifying those features will not be considered an argument for separate patentability. Accordingly these claims fall with claim 21.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 21 and 26 under 35 U.S.C. § 103(a) as unpatentable over Hendrey.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 22-25 and 27-30 under 35 U.S.C. § 103(a) as unpatentable over Hendrey and Goldhaber.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 21 and 26 under 35 U.S.C. § 103(a) as unpatentable over Hendrey is sustained.
- The rejection of claims 22-25 and 27-30 under 35 U.S.C. § 103(a) as unpatentable over Hendrey and Goldhaber is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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